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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/753,700	01/08/2004	William Steidle	WIESNER 3.0-004	8768

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EXAMINER

KAVANAUGH, JOHN T

ART UNIT PAPER NUMBER

3728

DATE MAILED: 11/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/753,700

Applicant(s)

STEIDLE, WILLIAM

Examiner

Ted Kavanaugh

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27, 29-32 and 34-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27, 29-32, 34-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Opening Remarks

It is noted in the claims that “fastening means” is not invoking 35 USC 112, 6th paragraph.

Claim Rejections - 35 USC § 112

1. Claims 47-48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The fastening means (i.e. tie and tag fasteners) has been claimed in claims 1 and 27 but in claim 47-48 additional “ties” are being claimed with no reference to the “fastening means” of claims 1 and 27 and therefore it is not clear if applicant is referring to the same or different fastening means.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-27,29-32,34-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2469708 (Alexander).

Alexander teaches footwear comprising a plurality of rectangular shaped hanging tabs (18; see figure 6) integrally formed as part of sole said on the perimeter edge of the sole and in the

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same plane of the sole (see figures 3 and 4) and a plurality of tie and tag fasteners (16) substantially as claimed except for the sole being rubber or plastic. It is old and conventional in the art to construct footwear soles out of rubber and plastic. Therefore, it would have been obvious to construct the sole of Alexander out of either plastic or rubber to facilitate cost.

Moreover, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

In re Leshin, 125 USPQ 416. Regarding the functional language (i.e. said hang tabs being removable (cutting-off)), the hang tags as taught above can be removed by being cut and therefore satisfy the functional language as claimed. Also, the hang tabs can be used for pairing and connecting a pair of soles of together.

4. Claims 1-27,29-32,34-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 3482335 (Ornsteen).

Ornsteen teaches footwear comprising a hanging tab (12) integrally formed as part of said sole on the perimeter edge of the sole (see figure 1 and 3) and in the same plane of the sole and fastening means (see col. 3, lines 6-48) substantially as claimed except for the sole being rubber or plastic. It is old and conventional in the art to construct footwear soles out of rubber and plastic. Therefore, it would have been obvious to construct the sole of Ornsteen out of either plastic or rubber to facilitate cost. Moreover, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Regarding the hanging tabs being located in different perimeter edges of the sole, see figure 1 and 3 which show them in different locations and col. 2, lines 70-72 where it teaches

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being placed at any desired location.

Regarding the particular shape of the hang tab, see col. 3, lines 55-59.

Regarding having the footwear having more than one hang tabs (e.g. a first hang tab, a second hang tab, a third hang tab, etc.) as claimed, it would be an obvious design choice to provide more than one hang tab. As noted above Ornsteen teaches the hang tabs can be in different locations and it would appear to be a design choice to provide more than one inasmuch as having tabs in a plurality of locations facilitate joining of pair of shoes in any desired orientations such as the shoes placed back to back and a plurality of hang tabs would facilitate holding the shoes together.

Regarding claims 47 and 48, figure 4 shows the ties (staple 25) connected to a display card (24).

Response to Arguments

5. Applicant's arguments filed Nov. 9, 2005 have been fully considered but they are not persuasive.

Applicant argues Alexander “does not teach or disclose protruding hang tabs integrally formed as part of the sole for connecting a pair of sole of footwear together”.

To the contrary, the purpose of Alexander is different from applicants but nonetheless it is inherently capable of performing the functional language as claimed.

Regarding applicant's arguments with respect to “integral”, it has been held that the term “integral” is sufficiently broad to embrace constructions united by such means as fastening and welding. *In re Hotte*, 177 USPQ 326, 328 (CCPA 1973). Therefore, each hang tabs, in the rejections above, are integrally formed as part of said sole inasmuch as fastening unites them.

Applicant argues, “the tab 12 on shoe ‘is attached to the bottom of the shoe upper’ (see figure 2)”.

To the contrary, figure 2 shows the tab (12) connected to the bottom of the outsole (13). Plus figure 1 and 2 show two alternative embodiments; see col. 2, lines 19-20 and 60-71.

Applicant argues that Ornsteen does not teach or disclose a plurality of hang tabs.

In response, the examiner previous rejection addresses this limitation inasmuch as it is a design choice. Applicant hasn’t provided any arguments with regard to the examiners rejection on this matter.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

7. **Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111, including:**

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-“The reply must present arguments pointing out the *specific* distinctions believed to render the claims, including any newly presented claims, patentable over any applied references.”

--“A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.”

-Moreover, “The prompt development of a clear issue requires that the replies of the applicant meet the objections to and rejections of the claims. Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP 2163.06” MPEP 714.02. The “disclosure” includes the claims, the specification and the drawings.


8. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Other useful information can be obtained at the PTO Home Page at www.uspto.gov.

In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (571) 273-8300 (**FORMAL FAXES ONLY**). Please identify Examiner Ted Kavanaugh of Art Unit 3728 at the top of your cover sheet.

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Ted Kavanaugh whose telephone number is (571) 272-4556. The examiner can normally be reached from 6AM - 4PM.

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Ted Kavanaugh
Primary Examiner
Art Unit 3728

TK
November 25, 2005